

REMARKS

Reconsideration of the Application respectfully is requested. For the reasons indicated hereafter the Application is urged to be in condition for allowance.

Applicant has provided an improved process for the impregnation of cellulose-based products with linseed oil and the resulting product. The process steps are designed through empirical research to well remove moisture that inherently is present in the starting material and to replace the moisture with protective linseed oil in the absence of a solvent under conditions designed by Applicant to achieve an optimal uptake of linseed oil. A hot treatment is sequentially followed by a cold treatment as described in Applicant's Specification so as to provide an improved impregnated product that can well withstand biological decomposition during use. The environmental shortcomings of an impregnation process that utilizes a halogenated organic solvent are completely eliminated and an improved final impregnated product is made possible.

There is no reference to the use of a solvent in Applicant's teachings. This concept now is expressly set forth in independent Claim 1 through the inclusion of "consisting essentially of" terminology. Such claim language excludes the presence of a solvent since the presence of a solvent with the linseed oil would invariably result in a material change of product characteristics. Workers are spared contact with a volatile deleterious solvent and the entrapment of residual solvent in the final product is precluded.

The "Double Patenting" concern identified at Page 7 of the Official Action has been addressed by making Claim 19 dependent on Claim 2 instead of Claim 9. It

would be inappropriate to consider Claim 19 as presently amended to be a substantial duplicate.

The continued rejection of presently solicited product Claims 10 and 20 under 35 U.S.C. § 102(b) over the different teachings of U.S. Patent No. 1,732,420 to Rice would be inappropriate. Rice employs a different composition requiring the presence of a saccharine and other chemicals to "poison" the wood with the poison being retained in the wood indefinitely (Page 2, lines 120 to 124), and different process conditions involving the usage of an "open" tank (Page 2, line 20). These different process parameters would by necessity always yield a different product. The withdrawal of the rejection is in order and respectfully is requested.

The continued rejection of product Claims 10 and 20 under 35 U.S.C. § 102(b) over the different teachings of U.S. Patent No. 2,860,070 to McDonald would likewise be inappropriate. In all embodiments the McDonald technology requires the usage of a solvent, such as chlorinated and/or fluorinated hydrocarbons, to treat the wood so as to extract components thereof that otherwise would be present within. Such solvents are recognized to be harmful to the atmosphere and would by necessity always be retained as a residue to some degree in the final product under the processing conditions that are described. The "consisting essentially of" terminology of Applicant's presently solicited claims precludes such solvents and such solvents would not be present in the product of presently solicited Claims 10 and 20. Also, as discussed in the Specification, Applicant's claimed parameters have been found to yield improved impregnation with an optimum uptake of linseed oil in the resulting product. The withdrawal of the rejection is in order and respectfully is requested.

The continued rejection of 1 to 5, 9 to 15, and 18 to 20 under 35 U.S.C. § 103(a) as being obvious to one of ordinary skill in the art over the different teachings of McDonald et al. would be similarly inappropriate. Applicant is claiming improved impregnation technology that is neither disclosed nor remotely suggested by McDonald. McDonald always contemplates in all embodiments the usage of a solvent that is recognized to be harmful, such as a chlorinated or fluorinated hydrocarbon. It would do violence to the reasonably derived teachings of McDonald et al. to carry out any type of an impregnation process in the absence of the contemplated solvent. Such solvent plays no role in Applicant's overall contribution which through the recited combination of process steps including a hot treatment/cold treatment as specified has been found to yield a highly desirable impregnated product wherein an optimal uptake of linseed oil is achieved. Applicant's contribution as presently claimed deserves full recognition. The withdrawal of the rejection is in order and is respectfully requested.

Finally, the continued rejection of Claims 6 to 8, 16, and 17 under 35 U.S.C. § 103(a) as being obvious to one of ordinary skill in the art over the different teachings of McDonald taken in view of those of U.K. Patent No. 701,633 to Kraft Foods would be similarly lacking a sound basis. The readily apparent deficiencies of McDonald are previously discussed. The Kraft Foods teachings provide no information that is capable of remedying the deficiencies of McDonald. Even if the reasonably derived teachings of McDonald and Kraft Foods were combined, Applicant's specifically claimed contribution still would not result. No prima facie showing of obviousness has been made. It is basic to the examination process that in order to establish prima facie obviousness of a claimed invention all of the claim limitations must be

taught or suggested by the prior art. See M.P.E.P. § 2143.03 in this regard. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*. 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim that depends thereon is nonobvious. The withdrawal of the rejection respectfully is requested.

If there is any remaining point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: AUGUST 8, 2005

By: Benton S. Duffett, Jr.

Benton S. Duffett, Jr.

Registration No. 22,030

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620